REMARKS

Applicant has studied the Office Action dated January 22, 2007 and has amended claims 1, 7 and 11. Claims 1-20 are pending. Claims 1, 7, 8 and 11 are independent claims. No new matter has been entered.

It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

§ 103 Rejections

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka et al. ("Tanaka" U.S. Pat No. 5,912,869) in view of Cho (U.S. Pat No. 5,375,249). Applicant respectfully disagrees with the Examiner's interpretation of Tanaka and traverses the rejection.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

It is further respectfully noted that "In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

With regard to independent claims 1, 7 and 11, it is respectfully noted that the claims have amended to recite a limitation similar to that already recited in claim 8, specifically recording byte-unit information indicating the number of bytes comprising the input data block together with the modulation-coded input data block and the selected at least one merging bit. It is respectfully submitted that the combination of the

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Tanaka and Cho references fails to disclose this limitation, which will be discussed specifically with respect to independent claim 8.

It is respectfully noted that the Examiner asserts, at page 6 of the Office action with respect to claim 8, that Tanaka discloses "recording byte-unit information indicating the number of bytes comprising each unit block together with modulation-coded data to which the at least one merging bit was added" at col. 12, ll. 24-56 and col. 12, line 65, to col. 13, line 30 and specifically asserts that the "number of bytes are represented through inversion periods are conversion." Applicant respectfully assumes that the Examiner meant to state "through inversion periods [and] conversion" and respectfully disagrees with the Examiner's interpretation of Tanaka.

It is respectfully noted that the disclosure at col. 12, ll. 22-24 of Tanaka is that "[d]ata is written to the optical disk in data blocks ... of 168X168 bytes." However, it is respectfully submitted that the disclosure is merely that the size of the data block is "168X168 bytes" with no disclosure of any recording of this information.

It is further respectfully noted that the disclosure at col. 13, ll. 18-29 of Tanaka is that the "code word sequence is expressed by the inversion periods of the NRZI signals corresponding to the code words" and of a "maximum inversion period" and a "minimum inversion period." It is respectfully submitted that there is no disclosure of any correspondence between the "inversion periods" related to "code words" and the number of bytes comprising the input data block given that the input data block is pre-coded data while the disclosed "code words" are data that has been coded. It is respectfully requested that the Examiner provide the basis for the assertion that this disclosure is analogous to the asserted "recording byte-unit information indicating the number of bytes comprising each unit block together with modulation-coded data to which the at least one merging bit was added."

It is respectfully submitted that Tanaka fails to disclose recording byte-unit information indicating the number of bytes comprising the input data block, as recited in independent claim 8. It is further respectfully submitted that Cho fails to cure the

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deficiencies of Tanaka with respect to <u>recording byte-unit information indicating the number of bytes comprising the input data block</u>.

Therefore, it is respectfully asserted that the Examiner has failed to meet the initial burden of presenting a <u>prima</u> <u>facie</u> case of obviousness with respect to claim 8 and it is respectfully requested that the rejection be withdrawn. It is further respectfully asserted that independent claims 1, 7 and 11, which have been amended to recite a similar limitation as claim 8, are allowable over the cited combination of references. Moreover, it is further respectfully asserted that claims 2-6, which depend from claim 1, claims 15 and 16, which depend from claim 7, claims 9, 10 and 17-20, which depend from claim 8, and claims 12-14, which depend from claim 11, also are allowable over the cited combination of references.

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CONCLUSION

In light of the above remarks, Applicant submits that claims 1-20 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Lee, Hong, Degerman, Kang & Schmadeka

Date: May 18, 2007

By: _____
Richard C. Salfelder
Registration No. 51,127
Attorney for Applicant

Customer No. 035884

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